REMARKS

In response to the above-identified Office Action, Applicant amends the application and seek reconsideration thereof. In this response, Applicant amends claim 5. Applicant does not cancel any claims. Applicant does not add any new claims. Accordingly, claims 1-3, 5, 7, 21 and 22 are pending.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attachment is captioned "Version With Markings To Show Changes Made."

I. Claims Rejected Under 35 U.S.C. §§ 102/103

Claims 1, 2, 21 and 22 stand rejected under 35 U.S.C. §§ 102(b) and 103 as being anticipated by or obvious over U.S. Patent No. 6,294,179 issued to Lee et al (hereinafter "Lee"). Applicant respectfully disagrees for the following reasons.

It is axiomatic that to anticipate a claim, each element of the claim must be disclosed in a single reference. Claim 1 includes the elements of a base comprising as a principal component a moisturizer. Conversely, Lee teaches a composition that is primarily a liquid skin washing composition that is primarily water, a surface active agent and abrasive particles. See Lee, col. 1 lines 56-59. The ingredients of the composition identified by the examiner are in line with this description with the addition of some thickening agents. The Examiner has failed to identify and Applicant has been unable to discern any part of Lee that teaches a base of a composition where a principal component is a moisturizer as claimed in claim 1. Rather, Lee teaches away from such a composition in stating that the use of a moisturizer in the composition is optional. See Lee col. 4, lines 3-5. Further, the discussion of the use of a moisturizer is in the subsection title 'Minors' referring to those materials that form a minor portion of the composition. Lee, col. 3, line 65.

Thus, Lee does not teach each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 1 are requested.

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests each of the elements of a claim. As mentioned above, Lee teaches away from a modification of its composition to make a moisturizer the principal component of its base. This modification would frustrate the purpose of the composition, which is to be a liquid cleanser for the human skin. Lee, col. 1, lines 56-59, see also MPEP § 2143.01, section titled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose." Also, the Examiner has not identified any part of Lee that teaches or suggests the desirability of modifying Lee to include a base having a moisturizer as a principal component. See MPEP § 2143.01; *In Re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 1 over Lee. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 1 are requested.

In regard to claims 2, 21 and 22, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not anticipated or obvious over Lee. Accordingly reconsideration and withdrawal of the anticipation and obviousness rejections of claims 2, 21 and 22 are requested.

Claims 1-3, 5, 7, 21 and 22 stand rejected under 35 U.S.C. §§ 102(b) and 103 as being anticipated by or obvious over U.S. Patent No. 3,092,111 issued to Saperstein (hereinafter "Saperstein").

Claim 1includes the elements of a base comprising as a principal component a moisturizer. Saperstein does not teach this element of claim 1. Rather, Saperstein teaches a composition that is used to treat acne and to induce dryness in human skin to the point of irritation. See Saperstein, col. 8, lines 59-64. Saperstein teaches that its composition must be non-oleaginous (i.e., not oily) and is used to dry out the skin thus Saperstein teaches away from the use of a moisturizer in which

to suspend abrasive particles. See Saperstein, col. 5, lines 45-50. The Examiner has failed to indicate and Applicant has been unable to discern any part of Saperstein that teaches that a principal component of its base is a moisturizer. Therefore, Saperstein does not teach each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 1 are requested.

As discussed above, Saperstein teaches away from the use of a moisturizer as a principal component of its base. Thus, Saperstein does not teach or suggest a modification of its base composition to have a moisturizer as a principal component. The Examiner has not indicated any part of Saperstein that teaches the desirability of such a modification. Rather, the modification of Saperstein to include a moisturizer as a principal component of its base would frustrate the intended purpose of the composition of Saperstein to combat acne by inducing dryness in the skin of the user. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 1 based on Saperstein. Accordingly reconsideration and withdrawal of the obviousness rejection of claim 1 are requested.

In regard to claims 2, 3, 21 and 22 these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not anticipated or obvious over Saperstein. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejections of claims 2, 3, 21 and 22 are requested.

In regard to claim 5, this claim as amended includes the elements of corundum particles with an average particle size less than 125 microns. The Examiner has not indicated any part of Saperstein that teaches the use of corundum particle in this size range. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 5 based on Saperstein are requested.

Further, Saperstein expressly teaches away from a modification of its composition to include corundum particles in the claimed range. Saperstein teaches that use of particles smaller in size than 125 microns leads to detrimental effects on hair follicles. Thus, one of ordinary skill the art would not think to modify Saperstein to used corundum particles with an average particle size

of less than 125 microns. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 5 are requested.

In regard to claim 7, this claim depends from independent claim 5 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 5, claim 7 is not anticipated or obvious over Saperstein. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejection of claim 7 are requested.

Claims 1-3, 5, 7, 21 and 22 stand rejected under 35 U.S.C. §§ 102(b) and 103 as being anticipated by or obvious over U.S. Patent No. 4,957,747 issued to Stiefel (hereinafter "Stiefel").

In regard to claim 1, this includes the element of a base having a moisturizer as a principal component. The Examiner has not identified any part of Stiefel that teaches a moisturizer. Rather, the Examiner has stated that Stiefel teaches emollients, implying that this teaches a moisturizer. An emollient is a substance that smoothes or softens the skin. See The American Heritage Dictionary of the English Language, Fourth Edition, (2000) Houghton Mifflin Company. This is not synonymous with a moisturizer. An emollient can also be a desiccant or an astringent. Thus, the Examiner has failed to identify any part of Stiefel that teaches a moisturizer being a principal component of the base. Further, Stiefel teaches that an aqueous base is only up to 10% an emollient. See, Stiefel col. 1, lines 44-47. Thus, the examiner has failed to indicate any part of Stiefel that teaches a moisturizer being a *principal* component of a base. Therefore, Stiefel does not teach each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 1 are requested.

Further, the Examiner has failed to establish that Stiefel teaches or suggests modifying its base to include a moisturizer as a principal component. As mentioned above, Stiefel teaches an aqueous base that is no more than 10% emollient. Further, the Stiefel teaches that its composition is intended to smooth and tighten skin. Stiefel, col. 2, lines 9-11. The Examiner has

not indicated and Applicant has been unable to discern any part of Stiefel that teaches or suggests the desirability of modifying its base c mposition to include a moisturizer. Therefore, Stiefel does not teach or suggest each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 1 are requested.

In regard to claims 2, 3, 21 and 22, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not anticipated obvious over Stiefel. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejection of claims 2, 3, 21 and 22 are requested.

In regard to claim 5, this claim as amended includes the elements of corundum particles with an average particle size less than 125 microns. The Examiner has not indicated any part of Stiefel that teaches the use of corundum particle in this size range. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 5 based on Stiefel are requested.

Stiefel, teaches a range of abrasive particle sizes of 170 microns to 600 microns. The Examiner has not indicated and Applicant has been unable to discern any part of Stiefel that teaches or suggests modifying the range taught by Stiefel to include an average particle size less than 125 microns or the desirability of such a modification. Thus, Stiefel does not teach or suggest each of the elements of claim 5. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 5 are requested.

Claims 1-3, 5, 7, 21 and 22 stand rejected under 35 U.S.C. § 103 as being obvious U.S. Patent No. 4,284,533 issued to Imamura et al (hereinafter "Imamura").

In regard to claim 1, this claim includes the elements of a moisturizer being a principal component of the base. The Examiner has failed to indicate and the Applicant has been unable to discern any part of Imamura that teaches or suggest thus use of a moisturizer, or a moisturizer being a principal component of the base. In fact, Imamura teaches away from such a base. Imamura teaches a liquid soap with abrasive particles having a very low viscosity. Imamura, col. 1, lines 10-15. Thus, the modification of Imamura to have a moisturizer as a principal component,

which would raise the viscosity of the composition, frustrates the intended purpose of the composition of Imamura which aims to be dispensable from a container and have a viscosity of less than 5000 cps. See Imamura, col. 1, lines 10-15 and col. 1, lines 50-55. Further, the Examiner has not identified any part of Imamura that teaches the desirability of such a modification. Thus, Imamura does not teach or suggest each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 1 are requested.

In regard to claims 2, 3, 21 and 22, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not obvious over Imamura. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 2, 3, 21 and 22 are requested.

In regard to claim 5, this claim, as amended, includes the elements of a base in the form of a cream. As mentioned above, Imamura teaches a liquid abrasive soap composition. Thus, Imamura does not teach a base in the form of a cream. Rather, Imamura teaches away from the use of a cream by teaching that it is necessary for its composition to have viscosity of less than 5000 cps. Thus, Imamura does not teach or suggest each of the elements of claim 5. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 5 are requested.

In regard to claim 7, this claim depends from independent claim 5 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 5, this claim is not obvious over Imamura. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 7 are requested.

II. Double Patenting

Applicant hods in abeyance a response to this provisional rejection until such time as the referenced application matures into a patent.